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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,598	01/20/2004	Peter M. Bonutti	JAS01-GN015-C2 (30099-65)	1100
94576 7590 08/06/2010 Eric T. Krischke (30099-Bonutti) Armstrong Teasdale LLP 7700 Forsyth Boulevard Suite 1800 St. Louis, MO 63105				
EXAMINER BROWN, MICHAEL A				
ART UNIT		PAPER NUMBER		
3772				
NOTIFICATION DATE		DELIVERY MODE		
08/06/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

uspatents@armstrongteasdale.com

Office Action Summary

Application No.

10/760,598

Applicant(s)

BONUTTI ET AL.

Examiner

MICHAEL BROWN

Art Unit

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 46-93 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 46-52, 55, 59, 64-71, 73 and 77-86 is/are rejected.
- 7) ☒ Claim(s) 53, 54, 56-58, 60-63, 72, 74-76 and 87-93 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

Claims 46-65, 79-80 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1 and 79, it is improper to recite that the base is coupled to a trunk of a person. The phrase "adapted to be coupled" should be recited instead of the phrase "coupled to".

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 46-53, 55, 64-71, 77-86 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor '643.

Taylor discloses in figures 1-4 a shoulder orthosis comprising a base section 31, an upper arm section 28, coupled to the base section, a drive assembly 20 operative couple to the upper arm section, a lower arm section 40, for receiving a lower portion of the arm, the drive assembly is operatively coupled to the upper and lower arm sections (fig.1), the lower arm section is capable of maintaining the lower portion of the arm substantially orthogonal to the upper arm portion, the drive assembly is capable of being operated by the patient and is capable of internal rotation of the humerus bone relative

to the scapula bone and external rotation of the humerus bone relative to the scapula bone, the drive assembly pivots the lower portion of the arm about an axis of the upper portion of the arm to effect rotation of the humerus bone relative to the scapula bone with an axis of the humerus bone substantially aligned with a center of a glenoid cavity defined in the scapula bone to limit movement of the scapula bone relative to the truck, the first drive assembly comprises a drive gear (a worm gear), a positioning assembly 23, for support the drive gear, the first drive assembly is capable of being operable to interrupt rotation of the humerus bone with viscoelastic body tissue stretched to an extent compatible with a comfort level of the patient, the first drive assembly is capable of maintaining tension in the viscoelastic body tissue interconnecting the upper portion of the arm and shoulder joint when operation of the first drive assembly is interrupted, the drive gear is fixedly coupled to the lower arm section (fig. 1) and a method of using the device as recited in claims 81-86.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 59 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Hepburn .

Taylor discloses in figures 1-4 an orthosis, substantially as claimed. However, Taylor doesn't disclose the drive assembly comprising a resilient member. Hepburn

teaches in figures 1-3 a resilient member 36 used to assist in moving a lower arm member. It would have been obvious to one having ordinary skill in the art at the time that the invention was made that the resilient member as taught by Hepburn could be incorporated into the orthosis disclosed by Taylor in order to use the resilient member to provide precision movement of the lower arm member.

Allowable Subject Matter

Claims 53-54, 56-58, 60-63, 72, 74-76, 87-93 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL BROWN whose telephone number is (571)272-4972. The examiner can normally be reached on 5:30 am-4:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco can be reached on 571-272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Brown/
Primary Examiner, Art Unit 3772